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Carlinco, Spicer & Kee, LLC 2003 S. Easton Road, Suite 208 Doylestown, PA 18901			EXAMINER SHELEHEDA, JAMES R	
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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte CHARLES A. ELDERING
11

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13 Appeal 2009-0696
14 Application 09/742,852
15 Technology Center 2400
16

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18 Oral Hearing Held: March 17, 2009
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22 Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,
23 and MARC S. HOFF, Administrative Patent Judges
24

25 ON BEHALF OF THE APPELLANTS:
26

27 ANDREW W. SPICER, ESQUIRE
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31

32 The above-entitled matter came on for hearing on Tuesday, March 17,
33 2009, commencing at 1:10 p.m., at the U.S. Patent and Trademark Office,
34 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown, Notary
35 Public.
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1 THE USHER: Calendar Number 16, Appeal 2009-0696. Mr. Spicer.

2 MR. SPICER: Good afternoon. I'm Andrew Spicer with Carlineo,
3 Spicer & Kee for Charles Eldering. With your permission, I'd like to discuss
4 the case with respect to independent claim 90, the method claim. The
5 elements of the two independent claims are -- the key elements anyway are
6 fairly similar so I would like to proceed with respect to that claim.

7 And as I think you can see from the briefs, the key points of
8 distinction here or of dispute are with respect to Doherty and Doherty's
9 teachings.

10 And I would simply submit that in view of what Doherty teaches, the
11 combination of Zigmond and Doherty just does not teach the modification of
12 a schedule or cue according to the displayed program content that is detected
13 as a result of the change in that content, and that is really element E of
14 independent claim 90.

15 The Examiner sets forth that Doherty's current conditions are used to
16 determine the next content.

17 And while Doherty does teach that the conditions of the system or the
18 conditions and the observations made in part by the user profile as well as
19 other parameters of the system, while those current conditions were the
20 conditions at the time of the change are used to formulate the next upcoming
21 advertisement, user profile or not or user interaction or not, which is part of
22 the dispute, those conditions do not include the currently displayed program
23 content that is post-change.

24 JUDGE HOFF: Counsel, are you saying that the Examiner's position
25 is -- that the Examiner does not rely on Zigmond for that teaching?

26

1 MR. SPICER: Well, actually, the Examiner seems to rely on
2 Zigmond for the teaching that program content after, or before for that
3 matter, of the currently displayed -- or the current program content is used in
4 Zigmond to determine what should come next. Okay?

5 The dispute seems to be when you put the two references together,
6 given the fact that Zigmond doesn't teach a cue or a schedule, and therefore
7 the modification thereof, that Doherty must then be used to teach the concept
8 of the cue and the schedule and the modification thereof.

9 And so in Doherty's cue, there is no modification based on the
10 currently displayed program content or, again, the program content detected
11 after the change.

12 And this is actually also a point of distinction that has been going
13 back and forth throughout the file history in that if, in fact, that is how the
14 Examiner is relying on Zigmond, it makes absolutely no sense under -- to
15 really insert a cue into Zigmond in the first place.

16 I realize this argument was briefed initially pre-KSR, but even post-
17 KSR, it doesn't make sense to do that.

18 In Zigmond, there is no reason to insert a cue because the whole point
19 of Zigmond is to insert or to determine then insert which ad you're going to
20 insert on the flier just prior to insertion.

21 JUDGE HOFF: So Zigmond teaches displaying a different
22 advertisement depending on what program content is displayed, correct?

23 MR. SPICER: In part, yes.

24 JUDGE HOFF: So if you had several commercials being inserted
25 over time in the Zigmond system, there would be an order to those
26 commercials, would there not?

1 MR. SPICER: I suppose the order would be the fact that they
2 occurred in an order. That is over time you have one insertion and then
3 another and then -- but there is no determination in Zigmond of that order
4 ahead of time or the change or the determination of an order upon changing
5 of a channel, for example.

6 So in other words, the way the claim is designed to work is that I am
7 watching TV. I or a different user changes the channel and, therefore, I am
8 now seeing different content. So the cue of advertisements that I have ready
9 to go is now changed or modified based on that newly displayed content.
10 Zigmond doesn't speak of any such thing.

11 JUDGE HOFF: I appreciate that as the disclosed invention, but are
12 you saying that that is, in fact, brought under the claim, that there is a
13 schedule *ex ante*?

14 MR. SPICER: I'm sorry?

15 JUDGE HOFF: That there is a schedule sitting somewhere basically
16 stored. I mean, obviously storing is not claimed, but there is a schedule
17 essentially stored in advance indicating what ads are to be displayed in the
18 invention that is claimed.

19 MR. SPICER: I think that is correct. I think the claim does --
20 although does not specifically claim or recite a storing of the schedule, there
21 is a cue that is generated and then reordered.

22 JUDGE HOFF: Continue.

23 MR. SPICER: So I think that our position with respect to Doherty's
24 teaching of reordering is clear. And there is also this -- a dispute or a
25 difference with respect to a user interaction and the user profile in Doherty.
26

1 Doherty's schedule or the reordering thereof is triggered solely on user
2 interaction. It has nothing to do with the actual program content.

3 Doherty's schedule or Doherty's user profile takes into account user
4 content but -- and Doherty also discloses that there is a -- that the user's
5 interests are taken into account in determining modifications of that user
6 profile, but nowhere does Doherty say that the actual program content
7 displayed renders the new schedule or renders how --

8 JUDGE HOFF: But the Examiner doesn't rely on Doherty to teach
9 showing a different ad based on program content.

10 MR. SPICER: You're correct. And again, that is where I think we
11 have a dispute exactly how it would really work. The modification or the
12 combination of the references just doesn't make sense in view of that.

13 If we were inserting a single ad into Zigmond -- see, you know, I can't
14 even explain it that way because the gist doesn't make any sense to insert a
15 cue into Zigmond. It is sort of nonsensical. So the only -- the dispute as
16 you've seen in the briefs has centered on exactly what Doherty teaches and
17 exactly how that modification occurs.

18 And then with respect to the user profile itself in Doherty, the
19 Examiner points out the example of restaurants being, you know, evidencing
20 currently displayed program content.

21 I would submit that the fact that the user likes restaurants or may have
22 an interest in restaurants or food or, you know, more generally, does not
23 mean that is actually the program content that is being displayed currently.

24 And I'm assuming that your position would be or your question would
25 be that, again, the Examiner doesn't rely on that for that teaching or Doherty
26 for that teaching.

1 And so then, you know, if we come to the combination of those two
2 references, our position is that the combination still lacks that teaching of
3 modifying the order in which the unscheduled ads are being inserted
4 according to the program content displayed as a result of the detected
5 change.

6 That is, Doherty's schedule even when modified or combined with
7 Zigmond is not reordered or modified according to the current program
8 content displayed as a result of the detected change.

9 Even though Zigmond may teach selecting ads based on currently
10 viewed programming, the resulting combination doesn't speak of any
11 modification of an order or list or cue schedule that are also reordered
12 according to program content. And that is even if one of those references or
13 both of those references detects a triggering event.

14 For example, Doherty's user interaction in saying I'm done or I'm
15 going to switch to something completely different. Zigmond simply doesn't
16 contemplate the use of a schedule and, therefore, cannot be relied on to teach
17 the reordering of the queue, so how in the world can we combine or add
18 Doherty's schedule to Zigmond? It just -- again, it just does not make any
19 sense.

20 And you can't infer from such a combination that the -- even if you
21 were to include Doherty's cue into Zigmond, you simply cannot infer, then,
22 that such a cue would be modified. The whole point of Zigmond is to select
23 just before insertion or to select one at a time at the very least.

24 And the -- even if you could get the concept of a queue, a list or a
25 predefined list or a prescheduled list of -- I shouldn't say prescheduled -- but
26

1 a preselected list of unscheduled ads into Zigmond, there is just simply no
2 suggestion that such a list would be modified at all.

3 JUDGE SAADAT: Mr. Spicer, would you characterize a totally new
4 set of advertisements to be shown as reordering of the queue? The content
5 changes, another set of advertisements are lined up to be shown totally
6 different. Is that the order?

7 MR. SPICER: I guess, if I can clarify, are you asking with respect to
8 one of the references or with respect to the claimed invention?

9 JUDGE SAADAT: One of the references. If the content changes,
10 and the ads are -- new ads are to be shown, would the claim read on that?
11 Because that happens in Doherty or --

12 MR. SPICER: I believe Doherty -- in view of preloading
13 advertisements to be shown, Doherty would teach the -- Doherty would
14 teach assigning a priority, if you will, to any ads that were relevant.

15 Perhaps Doherty would teach assigning a priority to all ads that were
16 available and then inserting those ads based on that priority. So in theory if
17 you got all the way down to the lowest-priority ads, those would be inserted
18 then too.

19 So your question was, would a completely new selection of ads or a
20 new list of ads that was previously not -- none of which were previously in
21 the cue?

22 JUDGE SAADAT: Correct. Or at least part of it wasn't.

23 MR. SPICER: Right. I think -- I mean, the claim does not specify. I
24 agree with that. Reordering the queue, I suppose, could include inserting
25 some new ads into the queue, but I don't know that that really renders any
26 difference with respect to combining the two references together, if you will.

1 In other words, I think that the -- you know, taking Zigmond's
2 insertion system with Doherty's -- and I realize there is a dispute or a
3 discrepancy here between exactly what the Examiner is relying on for the
4 purposes of current program content -- but if you insert Doherty's queue into
5 Zigmond's system, I don't think you end up with what we claim.

6 Did I answer your question?

7 JUDGE SAADAT: Yes. I just wanted to clarify what we mean by
8 "reordering" in the claim.

9 MR. SPICER: Again, I think that reordering, it could include some
10 new advertisements, but I don't think it means a wholesale change of
11 advertisements.

12 JUDGE HOFF: Figure 4 seems to suggest that the list of ads could be
13 completely different once the channel is changed.

14 MR. SPICER: I'm sorry?

15 JUDGE HOFF: Your figure 4 would suggest that you would get
16 completely different advertisements if you transition from one channel to
17 another.

18 MR. SPICER: I agree that --

19 JUDGE HOFF: So it is possible?

20 MR. SPICER: Yeah. I agree that there can be new ads inserted into
21 the queue.

22 Finally, perhaps a more minor point, but with respect to -- I just
23 wanted to highlight this with respect to something that was raised in the
24 briefs, we would submit that Doherty does not teach that schedule is altered
25 based upon the user's interactions.

26

1 The queue in Doherty is reordered in response to user interactions,
2 and although the user interactions could be taken into account or, more
3 precisely, a user's interests could be taken into account in Doherty in
4 generating a user profile, in that profile, there is no -- I guess I should say
5 there is no interactivity with respect to our claims.

6 JUDGE HOFF: I read this argument and it puzzled me because the
7 words of the claim say "as a result of," and I was wondering why the
8 argument in your brief wasn't directed to those exact words.

9 MR. SPICER: Yeah. And I think you raise a good point. I think
10 because the briefing -- because there was some history here, the briefing
11 initially did not hone in on those words. I think because both the Examiner
12 and we were hung up on this interactivity aspect. But I think it is more
13 correctly directed to as a result of the change detected in the prior element.

14 And so that is really actually the point I wanted to get to. The -- well,
15 I think that is enough said with respect to that.

16 So with that, we have no more points that we would like to discuss
17 today, but obviously if there are additional questions, I'll answer them.

18 JUDGE SAADAT: No more question.

19 JUDGE HOFF: I have nothing further.

20 JUDGE RUGGIERO: Thank you.

21 MR. SPICER: Thank you for your time.

22 (Whereupon, the proceedings at 1:27 p.m. were concluded.)